



PATENT

Attorney Docket No.: 42950.000036

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/638,560 Confirmation No.: 9964
Applicant : Bernard DeGroeve *et al*
Filed : August 14, 2000
Title : Electronic Multiparty Accounts Receivable and Accounts Payable System
TC/Art Unit : 3621
Examiner: : Firmin Backer

Docket No. : 42950.000036

Customer No. : 21967

Mail Stop: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below. This application was filed August 14, 2000. The Examiner rejected all the claims under 35 U.S.C. § 103 by U.S. Patent No. 6,041,312 to Bickerton and U.S. Patent No. 5,963,925 to Kolling in Office Action mailed November 13, 2002. Applicants provided arguments against the obviousness of the combination and made amendments to two of the claims. The Examiner rejected the claims under 35 U.S.C. § 103 by Bickerton and WO96/08783 to Stein in Final Office Action mailed April 7, 2003. In response to Applicants' Amendment submitted July 7, 2003 where certain dependent claims were rewritten in independent format, the Examiner *withdrew* the previous rejections and mailed a non-final Office Action on August 1, 2003. This

time, the Examiner rejected the claims under a new combination of U.S. Patent No. 6,070,150 to Remington and U.S. Patent No. 6,081,790 to Rosen. Applicants filed a Responsive Amendment on October 29, 2003. The Examiner issued a Final Office Action on January 2, 2004 applying a combination of Remington, Rosen and U.S. Patent No. 6,032,133 to Hilt under 35 U.S.C. § 103. Applicants submitted a first Appeal Brief on January 30, 2004. In response to the Appeal Brief, the Examiner *withdrew* the rejections and applied a new rejection of all the claims under 35 U.S.C. § 102(e) applying U.S. Patent No. 6,385,595 to Kolling. Applicants submitted a Response on September 29, 2004 arguing the clear deficiencies of Kolling. The Examiner maintained his rejections in a Final Office Action mailed December 22, 2004. Applicants submitted a second Appeal Brief on March 22, 2005 and a supplemental Appeal Brief¹ on July 8, 2005. In response, the Examiner *withdrew* his rejections for a third time and applied the current rejection mailed September 22, 2005 citing a “new” reference U.S. Patent No. 6,032,133 to Hilt. This “new” reference is the same Hilt reference applied in the Final Office Action mailed January 2, 2004. The Hilt reference was addressed in the first Appeal Brief of January 30, 2004, as part of a 103 rejection, where the Examiner fully considered this reference and deemed Applicants’ arguments persuasive.

To date, Applicants have submitted six (6) responses to Office Actions, including two extensive Appeal Briefs. As a result of Applicants’ submissions, all previous rejections have been withdrawn, without substantive amendments to the claims. In fact, the claims in both Appeal Briefs are identical. As the record reflects, the Office has found Applicants’ arguments persuasive in response to the all various prior art applied. Applicants find it particularly

¹ The supplemental Appeal Brief was filed to address formal matters, namely to indicate that no related appeals were pending and not no exhibits were relied upon, in Appendix B and Appendix C.

distressing that each of the later-withdrawn rejections failed to properly address each and every claim limitation. Accordingly, rather than proceeding with another expensive appeal, Applicants respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection or allow this application to proceed to appeal.

In each of the seven (7) Office Actions, the Examiner has completely failed to address all the independent claims and dependent claims, each reciting additional novel limitations. Rather, the Examiner has performed an improper cursory review of the first claim and has completely failed to provide any reasonable grounds for rejecting the other independent claims as well as any of the dependent claims. It is well understood that for a proper rejection, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 984-85 (C.C.P.A. 1974); *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”). Essentially, the Office Action ignores all other independent claims and all dependent claim terms and limitations by merely asserting that the applied reference “encompass all the limitations disclosed [sic] in the claims and related to the independent claims” and “[t]herefore, they are rejected under the same rationale.” (page 4, Office Action mailed September 22, 2005). The improper “catch-all” argument falls far short of complying with the Patent Office's burden to set forth a proper 102 rejection. The Examiner is required to provide a basis for each and every claim limitation, as recognized in MPEP §§ 706.02(j) and 2143.03, and has continued to fail to so here. In the response of October 30, 2003, Appeal Brief of January 30, 2004, response of September 29,

2004 and Appeal Brief of March 22, 2005, Applicants have requested a complete and proper examination of all pending claims. However, the Examiner continues to ignore these requests and continues to fail to provide any proper grounds of rejections for these pending claims. The Examiner has continued this improper examination for years now.

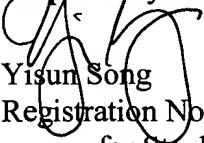
In each of the seven (7) Office Actions, the Examiner has failed to properly address the claim limitations for independent claim 1 -- the only claim out of claims 1-4, 6-9, 11-90, 93-145 and 155 that the Examiner has even attempted to address. The Examiner merely recites the claim limitations of claim 1 and provides a few irrelevant cites to the applied reference that *clearly* fail to show any of the claim limitations. In fact, none of the applied references to date have even come close to addressing the combination of claim limitations recited by Applicants, as evident by the Examiner's continual withdrawal of all his rejections. All the claims are clearly allowable as the Examiner has failed to apply prior art that anticipates or renders obvious the combination of claim limitations.

The Examiner withdrew the second Appeal Brief and re-opened prosecution alleging that "a new ground(s) of rejection is made in view of new found arts." The Examiner is applying the Hilt reference again, but this time under a 35 USC § 102(e) rejection. The same Hilt reference was applied by the Examiner as part of a 103 rejection where Hilt was the third reference in the combination of Remington, Rosen and Hilt. The improper nature and failure to render obvious the claims were fully discussed in the First Appeal Brief filed January 30, 2004. The Examiner withdrew his rejection involving the Hilt reference and found Applicants' arguments for non-obviousness persuasive. It is unclear as to how the Hilt reference, which was a third reference in a combination of three references, is now considered a 102(e) reference to the same claims, as the claims have not been amended since the Hilt reference was applied the first time. The

application of Hilt is further perplexing as the Examiner found arguments against Hilt persuasive the first time it was applied. Thus, as the Examiner has yet to uncover any relevant prior art, he is now recycling references that were applied, fully considered and deemed immaterial to patentability. The Examiner's actions are improper and each rejection of record is completely baseless. Applicants are entitled to a proper rejection on the merits, which has yet to be set forth in any of the seven (7) previous Office Actions. There is no doubt that the Examiner will continue to apply baseless improper rejections only to be withdrawn with the filing of another extensive Appeal Brief. A pre-appeal brief conference is necessary to address the improper conduct of the Examiner.

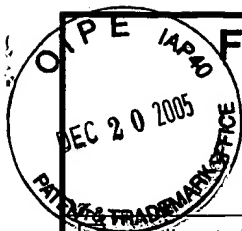
It is worth noting that Applicants have a related application, U.S. Patent Application Serial No. 10/160,689, pending before the same Examiner with the same deficiencies mentioned above. Thus, an appeal on the current rejections will certainly succeed, but the time and expense in preparing an appeal brief on these issue should not be borne by Applicant when the grounds are so clearly improper. Additionally, where there have already been seven (7) poorly-constructed and ultimately withdrawn prior rejections, Applicants deserve to finally receive a notice of allowance or a proper, fully-articulated rejection on the best art the Examiner can locate, so that Applicants can work with the PTO to bring this meritorious application to allowance without further delay.

Respectfully submitted,


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Date: December 20, 2005

**FEE TRANSMITTAL**

For FY 2005

MAIL STOP AF

Complete If Known

Application No.	09/638,560
Filing Date	August 14, 2000
Applicant(s)	Bernard DeGroeve et al.
Examiner Name	Firmin Backer
Art Unit	3621
Attorney Docket No.	42950.000036

☐ Applicant claims small entity status. See 37 CFR 1.27

Total Amount Of Payment (\$) **500.00**
METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (identify): _____
☒ Deposit Account Deposit Account Number **50-0206** Deposit Account Name: **Hunton & Williams LLP**

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below. ☐ Charge fee(s) indicated below, **except for the filing fee**
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments.

FEE CALCULATION**1. BASIC FILING, SEARCH AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee(\$)	Small Entity Fee (\$)	Fee(\$)	Small Entity Fee (\$)	Fee(\$)	Small Entity Fee (\$)	
Utility	300.00	150.00	500.00	250.00	200.00	100.00	
Design	200.00	100.00	100.00	50.00	130.00	65.00	
Plant	200.00	100.00	300.00	150.00	160.00	80.00	
Reissue	300.00	150.00	500.00	250.00	600.00	300.00	
Provisional	200.00	100.00	0.00	0.00	0.00	0.00	

2. EXCESS CLAIMS FEES

For	Number Present	Highest Number Paid For	Extra	Fees (\$)	Small Entity Fee (\$)	Fees Paid (\$)
Total Claims		20	0 x	50.00	25.00	
Independent Claims		3	0 x	200.00	100.00	
Multiple Dependent Claim				360.00	180.00	
Total Excess Claims Fees						

3. APPLICATION SIZE FEE (if the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).)

Total Sheets	Extra Sheets	No. of Each Additional 50 or Fraction Thereof	Fees (\$)	Small Entity Fee (\$)	Fees Paid (\$)
_____ - 100 = _____	_____ / 50 = _____	_____ (round up to a whole number) x	250.00	125.00	

4. OTHER FEE(S)

<input type="checkbox"/> Non-English Specification (no small entity discount)	<input checked="" type="checkbox"/> Utility Issue Fee (or Reissue) (including Publication Fee, if necessary)
<input type="checkbox"/> Surcharge - late provisional filing fee or cover sheet	<input type="checkbox"/> Plant Issue Fee
<input type="checkbox"/> _____ Month Extension of Time	<input type="checkbox"/> Petition to Commissioner
<input type="checkbox"/> Submission of Information Disclosure Statement	<input type="checkbox"/> Petition to Revive (Unavoidable)
<input checked="" type="checkbox"/> Notice of Appeal 500.00	<input type="checkbox"/> Petition to Revive (Unintentional)
<input type="checkbox"/> Request for Oral Hearing	<input type="checkbox"/> Petitions Related to Provisional Applications
<input type="checkbox"/> Filing Brief in Support of Appeal	<input type="checkbox"/> Recording Each Patent Assignment Per Property
<input type="checkbox"/> Filing Submission After Final Rejection	<input type="checkbox"/> Other (specify) _____

SUBMITTED BY

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